

REMARKS

This responds to the Office Action mailed on August 8, 2006.

Claims 1-3 and 5 were previously amended; as a result, claims 1-20 are now pending in this application.

§103 Rejection of the Claims

Claim 1 was rejected under 35 USC § 103(a) as being unpatentable over Fujimura et al. (U.S. 5,666,450) in view of Simon et al. (U.S. 4,386,821). Applicant respectfully traverses the rejection and requests the Office to consider the following.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (M.P.E.P. § 2143 8th Ed, Rev.4).

The Office states the following in the *Response to Arguments* section: “Fujimura teaches an optoelectronic device (60) mounted on a first portion of an upper surface of an insulating base (87)” (Office Action at page 2). This is not correct. Fujimura states and illustrates the “chip 60 is positioned on the submount (78)” (Fujimura at col. 13, lines 49-50). Further, the submount 78 is on an unlabeled structure. And the unlabeled structure alone is disposed on the base 87. Because neither Fujimura nor Simon teach a method that cannot operate upon a claimed structure, all the claim limitations are not taught in the cited references.

The *Response to Arguments* section also states how “this structure is anticipated by Fujimura in view of Simon.” (Office Action at page 2). Applicant respectfully asserts that a combination of two references cannot result in anticipation. Further, in Simon, there is nothing

to place Simon's LED on an upper surface of an insulating base (as required in the claims), because Simon's optoelectric structure is mounted on a metallic base 11, which by definition is conductive and not insulative. Consequently, the claimed method cannot be performed upon the claimed structure.

Claim 1 calls out specific structure upon which the method is carried out. Neither Fujimura nor Simon have this specific structure of

an optoelectronic device mounted on a first portion of an
upper surface of an insulating base;
a metal sealing member mounted to a second portion of the
upper surface of the insulating base, the second portion
surrounding the first portion;
and a metal cap coupled to the metal sealing member

(Claim 1). The method as claimed therefore cannot be carried out by Fujimura and Simon, alone or in combination. The Office Action admits that "Fujimura et al do not explicitly teach applying a first electrode to the metal cap, applying a second electrode to the metal layer and supplying a current between the two electrodes to weld the metal cap to the metal layer." (Office Action at page 4). Applicant agrees, but neither does Fujimura teach a method that operates upon the structure that is called out in the claim. Because all the claim limitations are not taught in the cited references, withdrawal of the rejections is respectfully requested.

Claims 2-5 and 8 were also rejected under 35 USC § 103(a) as being unpatentable over Fujimura et al. in view of Simon et al. and in further view of Thorwarth (U.S. 4,418,264). Applicant respectfully traverses the rejection and requests the Office to consider the following.

The Office Action admits that neither Fujimura nor Simon have the structural limitation of "the second electrode has multiple fingers or that the second electrode is coupled to an upper surface of the metal layer". (Office Action at page 5). Applicant agrees, but neither does Fujimura nor Simon teach a method that operates upon the structure of the hermetically-sealed optoelectronic package that is called out in the claim. Consequently, the claimed method cannot be performed upon the claimed structure.

The Office Action also states that the electrode of Thorwarth is cone-shaped (Office Action at page 5). But this is an oversimplification. Merely because a structure is “wider at the top and the width decreases at the bottom” (Office Action at page 5), does not mean it is cone-shaped. The electrode 3, 4 is concentric-cylindrical shaped with a chamfer at the joint between the two cylinders. This shape is “wider at the top and the width decreases at the bottom” (Office Action at page 5), but is not cone-shaped. Because all the claim limitations are not taught in the cited references, withdrawal of the rejections is respectfully requested.

Conclusion

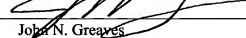
Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant’s attorney at (801) 278-9171 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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